

REMARKS

Applicants respectfully request that the Examiner contact the undersigned to schedule a case interview for the subject application.

Claims 1, 2, and 9 have been amended. Claims 1-10 are currently pending in the application.

On page 2 of the Office Action, claim 2 was objected to due to an antecedent basis issue. In particular, the Examiner alleges that the claim refers to "said prompting," and claim 1, from which claim 2 depends, does not recite "prompting."

Applicants have amended claim 2 to address the objection. Withdrawal of the objection is respectfully requested.

Claim 9 was objected to due to the claim's alleged failure to recite method steps as active steps. Applicants have amended claim 9 to address the objection. Withdrawal of the objection is respectfully requested.

Claims 1, 5, and 6 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent Application Publication No. 2004/0039712 (Tartal) in view of Official Notice.

In the Response to Arguments section on page 11 of the Office Action, the Examiner indicated that he has obtained copies of the provisional application nos. 60/212,596, filed on June 19, 2000, and 60/255,407, filed on December 15, 2000, to which the Tartal application claims priority. The Examiner alleges that the applications provide support for the invention disclosed in the Tartal publication.

Applicants have submitted herewith an English translation of the priority document of the subject application to perfect priority. As a result, the Tartal provisional application filed on December 15, 2000 has been removed as a reference, as the priority date (July 31, 2000) of the subject application is earlier in time than the filing date of the December 15, 2000 Tartal provisional application. Therefore, the Examiner may, at most, attempt to reject the claims of the subject application in light of the June 19, 2000 Tartal provisional application (hereinafter the first Tartal provisional application).

Independent claims 1 and 7 are patentable over the first Tartal provisional application, as the first Tartal provisional application does not disclose or suggest, "accepting designation of delivery terms on the screen from said delivery recipient after orders of said products," as recited

in claim 1, for example.

The first Tartal provisional application is directed to a system for delivering an item such as mail or packages to a customer. In the Tartal system, a customer will complete an application form and send it to a mail service provider such as a post office or a private delivery service in order to register his or her name and address. This action occurs before the customer has purchased any items to be delivered. When the customer purchases an item (online or in person) and requests that the item be delivered at the time of purchase, the item is shipped from the seller to the mail service provider nearest the delivery location, for example, a post office nearest to the customer's home). The customer can receive written notification or an email message that informs the customer that the item has arrived. The customer can then send an email to the mail service provider and request delivery of the item.

In the first Tartal provisional application, the merchant applies a barcode to a package to be shipped and prepares the package for shipment via the Postal Service. The Postal Service then scans the package, verifies the package, and generates an address label for delivery to the customer. See first Tartal provisional application, the page occurring after the page labeled as "6." The first Tartal provisional application provides no additional information regarding acceptance from a delivery recipient designation of delivery terms after orders of a product.

Although the first Tartal provisional application discloses a centralized labeling location, in such a location, the package is simply provided with another address label. It is the shipping system operator that applies the address label in the first Tartal provisional application. Having a shipping system operator apply an address label is not tantamount to or related to allowing acceptance of designation of delivery terms after orders of a product, as in the present invention.

Therefore, independent claims 1 and 7 are patentable over Tartal. As claims 5 and 6 depend from claim 1, dependent claims 5 and 6 are patentable over Tartal for at least the reasons presented for independent claim 1.

Similarly, the provisional application to which U.S. Patent Application Publication No. 2002/0046153 (Piggins) claims priority, does not disclose or suggest the above-identified feature of claim 1, for example. As the Piggins provisional is simply directed to communications between merchants and consumers, the Piggins provisional does not disclose or suggest, allowing acceptance of designation of delivery terms after orders of a product.

Therefore, claims 8 and 9 are patentable over Tartal provisional in view of Piggins and in view of Official Notice, as neither Tartal provisional nor the provisional of Piggins teaches or suggests the above-identified feature, nor can Official Notice be taken of the feature, as the

feature is not well-known and is not of common knowledge in the art capable of instant and unquestionable demonstration as being well-known.

On page 7 of the Office Action, claim 10 was rejected under 35 U.S.C. § 103(a) as being unpatentable over an anonymous article entitled, "SmartShip.com Announces Multi-Carrier Shipping and Tracking Function for E-Commerce" (Smartship), in view of Official Notice.

On page 8 of the Office Action, the Examiner acknowledges that Smartship does not expressly disclose that an item has been ordered. The Examiner, however, inappropriately takes official notice that it is well known to provide delivery information after an item has been ordered.

The Examiner's statement is traversed and applicant demands that the Examiner produce authority for the statement. The following errors are included in the Office Action.

First, the Examiner uses common knowledge as the principal evidence for the rejection. As explained in M.P.E.P. § 2144.03(E):

any facts so noticed should . . . serve only to 'fill in the gaps' in an insubstantial manner which might exist in the evidentiary showing made by the Examiner to support a particular ground of rejection. It is never appropriate to rely solely on common knowledge in the art without evidentiary support in the record as the principal evidence upon which a rejection was based.

Second, the noticed fact is not considered to be common knowledge or well-known in the art. In the current situation, the limitation is not of notorious character or capable of instant and unquestionable demonstration as being well-known. Instead, the limitation is unique to the present invention. See M.P.E.P. § 2144.03(A) ("the notice of facts beyond the record which may be taken by the Examiner must be "capable of such instant and unquestionable demonstration as to defy dispute").

Third, there is no evidence supporting the Examiner's assertion. See M.P.E.P. § 2144.03(B) ("there must be some form of evidence in the record to support an assertion of common knowledge").

Fourth, it appears that the Examiner also bases the rejection, at least in part, on personal knowledge. The Examiner is required under 37 C.F.R. § 1.104(d)(2) to support such an assertion with an affidavit when called for by the Applicant. Thus, the Examiner should support such assertion with an affidavit if the Examiner is relying on personal knowledge.

Regarding the Examiner's rejection of claim 10 as being unpatentable over Tartal in view of Official Notice, it appears that the Examiner also bases the rejection, at least in part, on

personal knowledge. The Examiner is required under 37 C.F.R. § 1.104(d)(2) to support such an assertion with an affidavit when called for by the Applicant. Thus, the Examiner should support such assertion with an affidavit if the Examiner is relying on personal knowledge.

In light of the foregoing, claim 10 is patentable over the references.

On page 11 of the Office Action, the Examiner stated that the common knowledge or "well-known in the art" statements in the previous Office Action are taken to be admitted prior art, as Applicants did not traverse Examiner's taking of Official Notice. On page 10 of the previous Amendment filed on March 18, 2005, Applicants clearly indicated that the facts asserted are not well-known, thereby appropriately challenging the Examiner's conclusions. Applicants further requested that the Examiner provide documentary evidence to support the assertion.

Therefore, the Applicants traversed the Examiner's taking of Official Notice and the "common knowledge or well-known in the art statements" in the previous office action are not taken to be admitted prior art, as the Applicants appropriately traversed the Examiner's taking of Official Notice.

If there are any formal matters remaining after this response, the Examiner is requested to telephone the undersigned to attend to these matters.

If there are any additional fees associated with filing of this Amendment, please charge the same to our Deposit Account No. 19-3935.

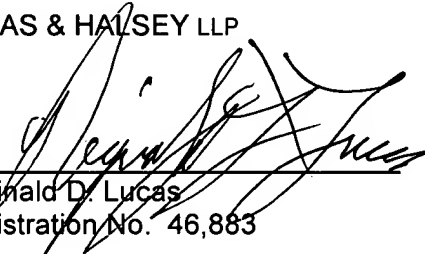
Respectfully submitted,

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